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P-3976-1

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANT: ALEXANDER M.L. KELLER
FOR: INJECTION MOLDED ARTIFICIAL FINGERNAILS AND
PACKAGING THEREOF
SERIAL NO.: 10/635,129
FILED: August 7, 2003

Commissioner of Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This is in reply to the Office Action of 05/16/2005.

Accompanying this reply is REVISED AMENDMENT PRACTICE providing instructions for amending claim 1 to overcome the 35 U.S.C. 103(a) rejection thereof, based on LaJoie et al. (5450864) in view of Park (D441192) and Prussen (5251751).

It is noted on the record that LaJoie et al. fails to disclose the method step of claim subset D and, although not similarly noted, LaJoie et al. also fails to disclose the method step of claim subset E.

The examiner is, however, apparently taking the position that Park in connection with claim subset E makes up for this missing disclosure of LaJoie et al. Applicant, however, argues otherwise, since while it is reasonable to assume that the empty compartments of the Park artificial fingernail case, with or without the second row, is a repository of the detached artificial fingernails of LaJoie et al., it is a stretch and clearly unreasonable to assume that the placement of the artificial fingernails are according to their location along the sprue. Rather, it is more

reasonable to assume that the placement in the Park artificial fingernail case was preceded by a tedious measurement of commingled artificial fingernails removed from the sprue of the injection molding machine.

Claim subset D has been amended to recite as positive limitations the synergism between the sizes and sprue locations of the artificial fingernails, and claim subset E now has reference to the artificial fingernails "as removed" from the sprue according to location, as dictating their placement in the size-designated compartments.

All words in a claim must be considered in judging the patentability of that claim against the prior art. In re Wilson, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). Furthermore, it is well established that the materials or apparatus on which a process is carried out must be accorded weight in determining the obviousness of that process. See In re Pleuddemann, 910 F.2d 823, 825-28, 15 USPQ2d 1738, 1740-42 (Fed. Cir. 1990); In re Kuehl, 475 F.2d 658, 664-65, 177 USPQ 250, 255 (CCPA 1973); Ex parte Leonard, 187 USPQ 122, 124 (Bd. App. 1974). It is submitted that the case law clearly establishes that the position of the examiner in this case is in error.


For the reasons set forth above, the decision of the examiner to reject claim 1 under 35 U.S.C. § 103(a) should be withdrawn.

Respectfully,

MYRON AMER, P.C.
Attorney for Applicant

114 Old Country Road
Suite 310
Mineola, NY 11501
(516) 742-5290

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By: 
Myron Amer
Reg.No. 18,650

REVISED AMENDMENT PRACTICE

1. (Currently amended) A method of packaging artificial fingernails according to graduated sizes correlated to sizes of natural fingernails comprising the steps of:

- A. packaging said artificial fingernails in a rectangular box-like container having a bottom delineated into ten compartments in two parallel rows of five compartments in each row and having a hinged lid thereon;
- B. positioning for display in an open condition of said lid a chart imprinted with numerical size designations correlated by corresponding two rows of five imprinted locations in each row to said compartments of said bottom;
- C. molding in an injection molding machine to produce product as a work-in-process a molded tree of polyvinyl chloride construction material characterized in
 - (1) having in said molded tree a sprue;
 - (2) having in attached adjacent spaced relation along said sprue ten work-in-process artificial fingernails of five in number on one side of said sprue and five in number on the other side of said sprue; and
 - (3) graduated sizes of said ten work-in-process artificial fingernails as determined by said spaced relation along said sprue being of the largest size at a center location on said sprue and the smallest size at a location on an end of said sprue and in graduated sizes therebetween;
- D. detaching said work-in-process artificial fingernails from said sprue of said tree from said sprue center location said work-in-process artificial fingernails of said largest size, from said sprue end locations said work-in-process artificial

fingernails of said smallest size, and from said remaining sprue locations between said center and end locations said work-in-process artificial fingernails of graduated sizes between said largest and smallest sizes; and

- E. placing in said size-designated compartments said detached artificial fingernails according to said locations thereof as removed from ~~on~~ said sprue;

whereby the sizing of said packaged artificial fingernails is facilitated without the tedium of having to be measured.